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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,784	11/28/2000	Marc A. Unger	020174-003000US	7684
20350	7590	01/21/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			OLSEN, ALLAN W	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			1763	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,784

Applicant(s)

UNGER ET AL.

Examiner

Allan W Olsen

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 11-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 6-10 in the response filed 10/20/2003 is acknowledged. However, Applicants remarks on page 8 contain content that conflicts with the parenthetical claim descriptors in the listing of claims on pages 2-7. Remarks section indicates applicant's intent to cancel claims 1-5 and 11-30 whereas in the listing of claims these claims are characterized as being "withdrawn". A claim that is "withdrawn" is one that is temporarily withdrawn from consideration but which remains pending. As the new listing of claims controls over applicants remarks, claims 1-5 and 11-30 remain pending but are withdrawn from consideration.

To provide applicant with the best possible examination, the examiner sought to transfer the application to an art unit that would be appropriate for the subject matter of the elected invention. The examiner's inability to do so highlighted the shortcomings of the previous requirement for an election of species. The examiner has been advised that a further requirement for an election of species would be appropriate. The examiner apologizes for issuing a second restriction requirement but in the interest of applicant receiving the best possible examination, the examiner believes this is the correct course of action. The following requirement for an election of species will focus on the elected claims (claims 6-10) and the elected specie (wherein the active device interacts with the flexible portion). However, should applicant wish to reconsider the previous election, applicant is reminded that claims 1-5 and 11-30 remain pending.

This application contains claims directed to the following patentably distinct species of the claimed invention: claims wherein the active device is:

1) (claim 7) an optical structure selected from the group consisting of:

- a) a photodiode
- b) a fiber optic device
- c) a fiber optic interconnect
- d) a light emitting diode
- e) a laser diode
- f) vertical cavity surface emitting laser (VCSEL)
- g) a micromirror
- h) a CMOS imaging array
- i) a CCD camera
- j) a waveguide
- k) a source/receiver of UV/Vis/IR radiation

2) (claim 8) an electronic structure selected from the group consisting of:

- a) resistor
- b) capacitor
- c) transistor
- d) chemical field effect transistor
- e) amperometric/coulometric electrochemical sensor
- f) accelerometer
- g) pressure sensor
- h) flow sensor
- i) electronic logic structure
- j) microprocessor
- k) chemical sensor
- l) strain gauge
- m) inductor

- n) actuator
- o) coil
- p) magnet
- q) electromagnet
- r) magnetic sensor
- s) radio frequency source
- t) radio frequency receiver
- u) microwave frequency source
- v) microwave frequency receiver
- w) radioactive particle counter
- x) electrometer

3) (claim 9) a thermal structure selected from the group consisting of:

- a) thermistor
- b) Peltier cooler
- c) resistive heater

4) (claim 10) an electrostatic electrode.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits (one of 1a-1k, or one of 2a-2x, or one of 3a-3c, or 4) to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claim 6 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Olsen whose telephone number is 571-272-1441. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Mills, can be reached on 571-272-1439.

The fax number for TC1700 is 703-872-9306 (non-after finals and after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1300.

Allan Olsen, Ph.D.
January 12, 2004

A handwritten signature in black ink, appearing to read "Allan Olsen", is written over the typed name and date.